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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/314,247 05/18/99 EGGERS

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EXAMINER

COHEN, L

ART UNIT

PAPER NUMBER

3739

DATE MAILED:

03/02/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/314,247

Applicant  
Eggers et al

Examiner  
Lee S. Cohen

Group Art Unit  
3739



☒ Responsive to communication(s) filed on Mar 20, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 80, 82, 84, 85, 87-92, 94-99, 102-106, and 108-143 is/are pending in the application.

Of the above, claim(s) 104, 115, and 132 is/are withdrawn from consideration.

☒ Claim(s) 80, 82, 84, 85, 87, 88, 94, 96, 98, 127-131, 133, 134, 139-141, and 149 are allowed.

☒ Claim(s) 89-92, 95, 97, 99, 102, 103, 105, 106, 108-114, 116-126, 135-138, and 148 are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**35 U.S.C. 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 89-92, 95, 97, 99, 102, 103, 105, 106, 108-114, 116-126, 135-138, 142 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 89 and 90 - "an instrument shaft" fails to clearly reference its antecedent. Claims 91 and 92 depend upon a cancelled claim and fail to add any additional structure since the source of conductive fluid has not been positively claimed. Claim 95 depends upon a cancelled claim and "the fluid delivery element" lacks antecedent basis. Claim 97 should reference the insulating, not electrode, support member. Claim 99 - "the target site" lacks antecedent basis. Claim 102 is vague because two insulating members are recited which are contradictory with respect to positioning the active electrode and "the distal end" in line 7 fails to fully reference its antecedent. Claim 104 - "the patient" lacks antecedent basis. Claim 108 - "the high frequency power supply" lacks antecedent basis. Claim 110 - the temperature sensor should only be adapted to be coupled to the voltage source since the source has not been positively claimed. Claim 115 - "the patient" lacks antecedent basis. Claims 118 and 119 - "an instrument shaft" fails to clearly reference its antecedent. Claims 120 and 121 fail to add any additional structure since the source of conductive fluid has not been positively claimed. Claim 122 should depend upon claim 110. Claim 124 - "the

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target site' lacks antecedent basis. Claim 125 fails to positively connect the power supply to the electrode terminal. Claim 126 - "the active electrode" lacks antecedent basis. Claims 135 and 136 - "an instrument shaft" fails to clearly reference its antecedent. Claims 137 and 138 fail to add any additional structure since the source of conductive fluid has not been positively claimed. Claim 142 should reference the insulating, not electrode, support member.

**Allowable Subject Matter**

*see* Claims 80, 82, 84, 85, 87, 88, 94, 96, 98, 127-134, <sup>1 133, 134,</sup> 139-141, and 143 are allowed.

Claim 89-92, 95, 97, 99, 102, 103, 105, 106, 108-114, 116-126, 135-138, 142 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

**Election of Species**

Claims 104, 115, and 132 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species. Claims 102, 110, and 127 require the return electrode connector to be on the shaft. Therefore, the return electrode cannot be on an external surface.

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Lee Cohen  
Primary Examiner